

## **REMARKS**

The Office Action of October 17, 2006 has been received and considered. Claims 1-35 are pending. Claims 1, 9, 17, 22, 26, 29 and 34 have been amended. Claims 2-8, 16, 18-21, and 30-33 have been canceled. Reconsideration of the application in view of the following remarks is respectfully requested. Each of the Examiner's rejections is discussed below.

### **Section 103**

#### **Claims 1-3, 5-19, 21-31 and 33-35**

Claims 1-3, 5-19, 21-31 and 33-35 have been rejected under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2004/0002665 to Parihar ("Parihar"), in view of U.S. Patent No. 5,230,249 to Sasaki et al. ("Sasaki") or U.S. Patent No. 6,014,823 to Lakic ("Lakic"). This rejection is respectfully traversed.

The proposed combination of Parihar and Sasaki or Lakic, does not disclose or make obvious a reservoir of magneto-rheological fluid in an upper; with a magnet assembly comprising a plurality of electromagnets and a load cell configured to activate the electromagnets upon detection of a force from a user's foot and positioned in a sidewall of the upper.

Initially, Applicant notes that processor 518 of Parihar is not a load cell that activates electromagnets upon detection of a force. Rather, 518 is merely a processor used to turn the power supply on and off. It simply is not a load cell.

Sasaki and Lakic have no such magneto-rheological fluid or electromagnets, let alone a load cell. Additionally, Applicant notes that Demon's pressure sensing device 104 is located in the sole of the shoe.

Additionally, Applicant respectfully submits that the proposed combination of Parihar and Sasaki or Lakic is improper.

In order establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three

criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

It is well-grounded that a proposed modification is not obvious if the cited references teach against the proposed modification, and it is well-grounded that a prior art reference must be considered in its entirety including portions that teach against the claimed invention. *See e.g., W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Applicant has previously presented the position that the proposed combination of Parihar and Sasaki is improper since the proposed combination with would defeat the intended purpose of Sasaki, which need not be repeated here.

The Office Action now asserts the “the modifying references to Sasaki and Lakic have been provided only to teach that it is known to provide reservoirs in the upper of footwear in addition to the sole for increase (sic) support of the foot.” (Page 4, paragraph 4.)

Applicant respectfully submits that the Sasaki and Lakic references are proposed **in combination with Parihar**. That is, they are used not only to teach about reservoirs in an upper, but that one skilled in the art would have combined the reservoirs of Sasaki and Lakic with the teachings of Parihar. As discussed, such a proposed combination is improper.

Consequently, the rejection is improper and should be withdrawn.

#### **Claims 4, 20 and 32**

Claims 4, 20 and 32 have been rejected under 35 U.S.C. § 103(a) over Parihar and Sasaki in view of U.S. Patent No. 5,813,142 to Demon (“Demon”). Demon is cited as disclosing an article of footwear that transforms from one state to another upon detection of a force from a user’s foot. This rejection is respectfully traversed.

Demon fails to overcome the deficiencies of Parihar, Sasaki, and Lakic noted above.

Accordingly, the rejection is improper and should be withdrawn.

**Conclusion**

Pending claims 1, 9-15, 17, 22-29, and 34-35 are believed to be in form for allowance, and an indication to that effect is respectfully requested at this time. Please apply any charges or credits to Deposit Account No. 19-0733.

Respectfully submitted,

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